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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,583	10/30/2003	William J. Farrell JR.	548.0001	7235
25534 7590 CAHN & SAMUELS LLP 1100 17th STREET NW SUITE 401 WASHINGTON, DC 20036			EXAMINER GILBERT, WILLIAM V	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 07/22/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/696,583

**Applicant(s)**

FARRELL ET AL

**Examiner**

William V. Gilbert

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 14-21 is/are pending in the application.  
4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CDC)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This is a Final Office Action. Claims 1 and 14-21 are pending. Claims 2-13 have been cancelled. Claims 14-20 have been withdrawn from consideration. Claims 1 and 21 are examined.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 4,611,450) in view of Strand (U.S. Patent No. 1,664,837), Sacks (U.S. Patent No. 6,820,387) and Ritter (U.S. Patent No. 6,272,805).

Claim 1: Chen discloses a construction panel with outer and inner wire mesh members (Fig. 2-3: 223) and a middle member (10, 14, 16 and 30) comprised of wire trusses and polystyrene foam (abstract, line 11) disposed between the outer and inner mesh members and positioned to define a first gap (see e.g. Fig. 2-3 231) between the middle member (portions 10, 14 and 16) and the outer mesh member and a second gap (Fig. 2-3: 231) between the middle member and inner mesh, the middle member is connected to the inner and outer mesh members by attaching the mesh to the trusses on outside ends of said middle member (see Fig. 2-3 the apex of the truss, proximate 232) and an outer layer of a cement material (Claim 8) is on the members.

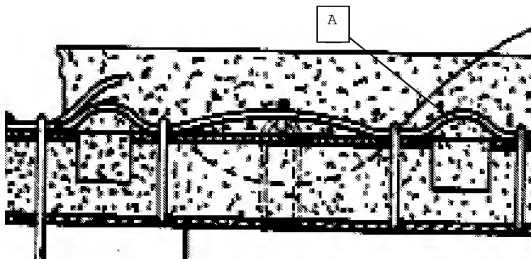
While Chen discloses a mesh member (223), it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) and having outwardly pointing apexes (see "A" from attached Fig. 2 from Strand below). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mesh in

Strand as the mesh in Chen because the two mesh screeds would perform equally as well as functional equivalents. Further the prior art of record does not disclose the dimensions of the mesh or ridges. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

In addition, while the Strand reference discloses outwardly projecting apexes, it does not disclose they are V-shaped, however Sacks discloses a V-shaped ridge (see Fig. 2: proximate 13, though noted that the ridges do not project in the same direction as Strand, only the shape of the ridge is considered.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art

as a matter of design choice to have this limitation because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04.

Last, while the prior art of record discloses a cement material as a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2) it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because as disclosed in Chen (claim 8) numerous cement based materials may be used, and concrete is a cement based material and would perform equally as well depending on the desired effect of the outer layer of the panel.



**Figure 2 from Strand**

Claim 21: Chen discloses a construction panel with a pair of mesh members (223), a middle member (10, 14, 16 and 30) comprising a plurality of layers and polystyrene (abstract) disposed between the mesh members connected to the inner and outer mesh members by attaching the mesh to trusses on outside ends of the middle member (see Fig. 2-3: proximate 232 is an outside end of the middle member), and outer layers of a cement based material (claim 8) on the faces of the member.

While Chen discloses a mesh member (223) it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) having outwardly pointing apexes (see "A" from attached Fig. 2 from Strand above). It

would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mesh in Strand as the mesh in Chen because the two mesh screeds would perform equally as well as functional equivalents. Further the prior art of record does not disclose the dimensions of the mesh or ridges. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

In addition, while the Strand reference discloses outwardly projecting apexes, it does not disclose they are V-shaped, however Sacks discloses a V-shaped ridge (see Fig. 2: proximate 13, though noted that the ridges do not project in the same direction as Strand, only the shape of the ridge is



considered.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04.

Last, while the prior art of record discloses a cement material as a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2), it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because as disclosed in Chen (claim 8) numerous cement based materials may be used, and concrete is a cement based material and would perform equally as well depending on the desired effect of the outer layer of the panel.

***Response to Arguments***

2. The following addresses applicant's remarks/arguments dated 25 April 2008:

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as applicant amended the claims.

***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635

/Basil Katcheves/

Primary Examiner, Art Unit 3635